



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/527,440	03/17/2000	Hiroki Nakae	HIRA.0003	3095

7590 05/20/2002

Stanley P Fisher  
Reed Smith Hazel & Thomas LLP  
3110 Fairview Park Drive  
Suite 1400  
Falls Church, VA 22042-4503

[REDACTED] EXAMINER

CLOW, LORI A

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

1631

DATE MAILED: 05/20/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/527,440	NAKAE ET AL.
Examiner	Art Unit	
Lori A. Clow, Ph.D.	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4, 7, 19, 20, 22 and 30-32 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4, 7, 19, 20, 22 and 30-32 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### ***Claims Rejections-35 USC 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 1631

4 22

Claims 1-4, 19-20, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vijg et al. (WO 98/06872; US 6,007,231) in view of Xu et al. (Genomics (1998) vol. 47, p.171-179).

As stated in the previous office action, the claims are drawn to systems for designing primers useful for PCR. The system comprises a variety of means to identify a plurality of potential primer sequences from DNA sequences extracted from a database of DNA sequences by using selection conditions of base length, T<sub>m</sub>, GC content, etc. The system further comprises means to position the primer sequences against the original DNA sequence, select appropriate pairs of those sequences in order to be able to use for the PCR of exons in the DNA sequence, and collate the information. The system does not set forth that ~~these~~ means must all be interrelated or interconnected in any way. The claims drawn to the computer software product, which mimic the above system, also do not set forth any specific interrelatedness, or particular series of steps that must be performed in a certain order.

Vijg et al. (WO 98/06782; US 6,007,231) disclose the system, software, and methods for designing primers that comprise each of the recited means, and result in the selection and correlation of PCR primers with exons of DNA sequences that have been retrieved from a database. Figures 6-8 of Vijg et al. clearly identify the means and functions disclosed in the publication, and how those means and functions are used to identify and design PCR primers (see also pages 17-19 and 23-28). Design parameters include base length, GC content etc., as well as position in relationship to an exon, sequence similarity to other sequences, etc. Vijg et al. specifically note that primers for the amplification of multiple exons from a gene can be identified, designed, and collated by the disclosed system (page 5, line 22). Vijg et al. indicate

Art Unit: 1631

that genes of varying known function can be analyzed, meeting all of the limitations of the instant claims except the limitation of "predicted exons". However, Xu et al. meet that limitation.

Xu et al. teach a new experimental protocol which is able to identify exon boundaries. ExonPCR, bypasses the isolation, characterization, and DNA sequencing of subclones from genomic DNA to determine exon boundaries (see abstract). More specifically, Xu et al. teach the ExonPCR algorithm, used to predict a plurality of different exons. The algorithm divides the DNA into regions of the following three types: (E) no splice site, (I) splice site, and (U) unknown.  $k$  pairs of primers are designed in the first round of PCR and later rounds subdivide each region until the desired resolution is reached (p. 175, paragraphs 1 and 2). This method relies upon the use of database queries to retrieve sequence information (p. 178, paragraph 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Vigj et al. so as to further include the step of predicting exons, rather than just using known exons, as taught in Xu et al.

No claim is allowed

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1631

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

All claims are rejected.

*Inquiries*

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242, or (703) 308-4028.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lori A. Clow, Ph.D., whose telephone number is (703) 306-5439. The examiner can normally be reached on Monday-Friday from 10A.M. to 6P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Patent Analyst, Bill Phillips, whose telephone number is (703) 305-3419, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

Application/Control Number: 09/527,440  
Art Unit: 1631

Page 6

May 15, 2002

Lori A. Clow, Ph.D.  
Art Unit 1631  
*Lori A. Clow*

*M.P.W*  
MICHAEL P. WOODWARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600